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10/670,046

09/24/2003

Frank Hardt

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EXAMINER

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK HARDT and PAUL GENICH

Appeal 2008-1248
Application 10/670,046
Technology Center 1794

Decided: August 28, 2008

Before, BRADLEY R. GARRIS, JEFFREY T. SMITH,
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

ORDER UNDER 37 C.F.R. § 41.50(d)

In order to reach a reasoned decision on this Appeal, the Board requires clarification on several matters as discussed more fully below. Therefore, pursuant to 37 C.F.R. § 41.50(d), Appellants are given a non-extendable time period of TWO (2) MONTHS to respond to this order. Failure to timely comply with this order may result in sua sponte dismissal of the appeal. *Id.*

Appellants request review, *inter alia*, of the Examiner's rejection of claims 1-8 under 35 U.S.C. § 112, first and second paragraphs. The Examiner rejects claims 1-8 under 35 U.S.C. § 112, second paragraph, indicating:

[A]ppellants' earlier amendment to claim 1 that "the matrix layer being a compacted material" is believed to be vague, indefinite and confusing since the specification contains no teachings (with the cancellation of former claim 9) as to just what constitutes a "compacted material". Note that in Paragraph [0031] the specification recites only that the matrix material can be a "compacted material, foam, fabric, porous sheet, nonwoven fabric, etc." which unfortunately provides no guidance as to what a "compacted material" can comprise. Note also that now cancelled claim 9 taught that a compacted material suitable for use could, however, be any one of the last four embodiments. Accordingly, one of ordinary skill can only guess as to just what a suitable "compacted material" is, since although the Examiner does not deny that the term "compacted material" is known in the dictionary there are also many embodiments which are clearly nonoperative. The specification, however, provides no additional guidance as regards this issue.

(Ans. 3.) The Examiner also makes a "closely related" (Ans. 5) rejection under 35 U.S.C. § 112, first paragraph. In this regard, the Examiner finds that the claims fail to comply with the enablement requirement of § 112, first paragraph, because:

The claim(s) contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. More particularly, as was described in the preceding grounds of rejection the specification in its present form is believed to shed no light as to just what embodiments constitute a suitable "compacted material". Note again that cancelled claim 9 taught that a compacted material could be selected from the group consisting of a foam, a fabric,

a porous sheet or a non-woven fabric, but in the specification the only discussion of what a compacted material is can be found in Paragraph [0031] which teaches only the equivalence of a “compacted material” with any of the four embodiments which were also set forth in the Markush grouping of cancelled claim 9. Note also that while the Examiner does not contest the fact that “compacted materials” are known in the literature (as is evidenced by appellants’ recently provided citations, etc.) the fact also remains that many other “compacted materials” such as, e.g. many crushed or compacted elements, are also clearly non operative.

(Ans. 3-4 (emphasis in original).)

The relevant inquiry under § 112, second paragraph, is whether the claims delineate to a skilled artisan the bounds of the invention. *See In re Venezia*, 530 F.2d 956, 958 (CCPA 1976). “The definiteness of the language employed must be analyzed—not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.” *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971).

“[T]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without ‘undue experimentation.’” *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993). The initial burden of presenting reasons or evidence to support this type of rejection rests with the Examiner, and, if met, the burden shifts to Appellants. *See id.* Specifically, the Examiner must advance acceptable reasoning inconsistent with enablement. Thereupon, the burden shifts to Appellants to show that one of ordinary skill in the art could have practiced the claimed invention without undue experimentation. *In re Strahilevitz*, 668 F.2d 1229, 1232 (CCPA 1982).

In order for us to reach a decision on the Examiner's § 112 rejections, it is necessary for us to evaluate the scope and meaning of the claims in light of the Specification. *See Moore*, 439 F.2d at 1235. We especially note that the meaning of claim term "compacted material" is at issue in this case. (*See* Ans. 3-4.) For this reason and because enablement is determined as of the effective filing date of the patent, *In re Hogan*, 559 F.2d 595, 604-05 (CCPA 1977), it is imperative that we consider the correct Specification. In particular, as is set forth below, the record reflects that PCT/EP99/05562, which is in the German language, is the Specification at issue in this case. However, we currently do not have access to this document, but instead, have related German language application WO 00/10781. Also as set forth below, our review of WO 00/10781 necessitates a requirement by this Board that Appellants provide a verified English translation of PCT/EP99/05562, as well as WO 00/10781. *See* 35 USC § 372(b)(3).

The record reflects that the application at issue (10/670,046) is a continuation application of Application No. 09/763,268, which is the National Stage of International Application No. PCT/EP99/05562, filed August 2, 1999. (Translation [0001].)¹ A national stage filing of an international application requires, *inter alia*, "a copy of the international application . . . and a translation into the English language of the international application, if it was filed in another language." 35 U.S.C. § 371(c)(2). A national stage filing also requires "an oath or declaration of the inventor . . . complying with the requirements of [35 U.S.C. § 115] and with

¹ We use the indicator "Translation" to refer to the English language translation of the Specification of the German language international application (PCT/EP99/05562) believed to be at issue in this case.

regulations prescribed for oaths or declarations of applicants.” 35 U.S.C. § 371(c)(4). Applicants entering the national stage in the U.S. are required to file an oath or declaration of the inventor in accordance with 37 C.F.R. § 1.497(a) and (b). 37 C.F.R. § 1.497(c). One requirement identified in 37 C.F.R. § 1.497(a) is that the declaration “identifies the specification to which it is directed.” The record reflects that the Specification identification portion of the declaration of the instant application is as follows:

SPECIFICATION IDENTIFICATION

the specification of which: (complete (a), (b), or (c))

- (a) ☐ is attached hereto.
- (b) ☒ (X) was mailed on **February 20, 2001** as ☐ Serial No. _____ or
☒ (X) Express Mail No. **EL148507770US**, as Serial No. not yet known
and was amended on _____ (if applicable); **and (c) below**
- (c) ☒ (X) was described and claimed in PCT International
Application No. **PCT/EP99/05562** filed on **August 2, 1999** and as amended
under PCT Article 19 on _____ (if any).

Above is an excerpt from the Declaration of the instant application, indicating, *inter alia*, that the Specification of the instant application “was mailed on February 20, 2001 as . . . Express Mail No. EL148507770US” and “was described and claimed in PCT International Application No. PCT/EP99/05562 filed on August 2, 1999.” A different portion of the Declaration indicates the instant application is a “national stage of PCT,” yet the Declaration of the instant application claims foreign priority benefits under 35 U.S.C. § 119 of “German Appln. 198 37 764.9 filed August 20, 1998” and “PCT Appln. PCT/EP99/05562 filed August 2, 1999.”

The record also reflects that the specification of PCT/EP99/05562 was published in the German language as WO 00/10781 on March 2, 2000. WO 00/10781 is attached to this order.

While this panel has been unable to view the paper file of Application No. 09/763,268, we have electronic access to a 34 page document entitled “TRANSMITTAL LETTER TO THE UNITED STATES ELECTED OFFICE (EO/US) (ENTRY INTO U.S. NATIONAL PHASE UNDER CHAPTER II).” This document is said to have been deposited with the United States Postal Service on February 20, 2001, and was given Mailing Label Number EL148507770US. The document is also said to contain “[a] copy of the International application as filed” as well as “[a] translation of the International application into the English language.” However, we cannot find a copy of an International application within the document.

Because the identity and translation of the Specification at issue in this application is in doubt, we require Appellants to clarify the record as follows:

1. If Appellants dispute our interpretation of the record set forth above, including, but not limited to the status of PCT/EP99/05562 as the Specification in this case, Appellants are to elaborate upon any such dispute, and provide relevant supporting documentation (if any).
2. Appellants are required to provide a verified translation of PCT/EP99/05562, as well as a verified translation of WO 00/10781. *See* 35 USC § 372(b)(3).

3. In the context of PCT/EP99/05562, Appellants are specifically required to provide the most accurate English translation of the German language phrase “als kompaktes Material”? (See WO 00/10781 at 6.) In this regard, we observe that “als kompaktes Material” may refer to “compact material” whereas instant claim 1 refers to “compacted material.”²

4. In the context of PCT/EP99/05562, Appellants are required to indicate whether “Schaum, Gewebe, poröse Folie, Vlies etc.” are examples of “kompaktes Material,” or alternatives to “kompaktes Material.”³ (See WO 00/10781 at 6.)

ORDER

Appellants are ordered to respond to the four issues identified above. Appellants are given TWO (2) MONTHS to submit briefing and information sufficient to address these issues. This deadline is non-extendible. 37 C.F.R. § 41.50(d).

² We note that the German phrase “als kompaktes Material” as translated into English using a mechanical translator is “as compact material,” and the English phrase “as compacted material” as translated into German using a mechanical translator is “als verbundenes Material.” See <http://babelfish.altavista.com> (accessed 04/14/2008).

³ We note that claim 9 as filed (but now canceled) in the instant application reflected that foam, i.e., “Schaum” (See WO00/10781 at 6), is an example of “compacted material.”

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**FAILURE TO RESPOND AND COMPLY TO THIS ORDER
WITHIN THE TWO MONTH TIME FRAME MAY RESULT IN SUA
SPONTE DISMISSAL OF THIS APPEAL. 37 C.F.R. § 41.50(d)(2006).**

ORDERED; 37 C.F.R. § 41.50(d)

tf/ljs

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